

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte MATTHEW M. HENRY

---

Appeal No. 1999-0681  
Application No. 08/697,478

---

ON BRIEF

---

Before MCCANDLISH, Senior Administrative Patent Judge, COHEN and STAAB, Administrative Patent Judges.

MCCANDLISH, Senior Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has requested a rehearing from a new ground of rejection which we introduced pursuant to 37 CFR § 1.196(b) in our decision mailed January 31, 2001 (Paper No. 22). In that decision, we reversed the examiner's rejections of the appealed claims and, pursuant to the provisions of 37 CFR § 1.196(b), rejected the appealed claims under the first paragraph of 35 U.S.C. § 112 as being based on a specification which, as filed, does not satisfy the description requirement in that paragraph. We have carefully

considered appellant's request, but find nothing to persuade us that our decision to reject the appealed claims under the first paragraph of § 112 was in error.

In support of our new rejection, we held that there was no descriptive support in the original specification, including the original claims, or the original drawings for the recitation in claim 1 that the shoulder (18) is "formed on the inside of the conical [sic] shaped wall," for the recitation in claims 1, 5 and 14 that the shoulder is formed "at the second end of the [conical shaped] wall," and for the recitation in claim 14 that the shoulder is "formed in the inside surface of the conical [sic] shaped wall" (see pages 8-9 of our decision). Instead, as noted on page 9 of our decision, Figure 2 of appellant's drawings shows that the shoulder is formed in an axially extending cylindrical end portion adjoining a conically shaped wall portion.

Appellant does not challenge our finding that the shoulder is in the cylindrical wall portion, rather than the adjoining conically shaped wall portion. Instead, appellant contends that we erred in our rejection by referring to the claimed "conical shaped wall" as a "conically shaped wall." In particular, appellant contends that we erred by interpreting the word "conical" too narrowly as meaning "conical throughout its entire length" (request for rehearing, page 2).

In this regard, appellant contends on page 2 of his request for rehearing that "the phase, [sic] 'conical shaped wall' must include the cylindrical portion . . ." On page 5 of the request for rehearing, appellant further contends that the term "conical" is "broadly understood in the art to mean an interface between a pipe and a catalytic converter" with the result that it may include shapes other than the dictionary meaning of the word "conical." As we understand appellant's position, a "conical shaped wall" differs from a

“conically shaped wall” in that it may include shapes other than conical shapes, namely a cylindrical shape. We do not agree with this interpretation. Moreover, it is not supported by appellant’s specification as filed.

In our decision, we never intimated that the appealed claims literally recite a “conically shaped wall.” We did, however, refer to the claimed “conical shaped wall” as a “conically shaped wall” because the expression “conical shaped wall” is grammatically incorrect.<sup>1</sup> In this regard, the word “conical” is an adjective and therefore may only serve to modify a noun or a pronoun. However, the word “shaped” is not a noun or a pronoun, but instead is the verb “shape” in the past tense. Therefore, the use of the adverb “conically” is grammatically appropriate for modifying the verb “shaped” in the past tense.<sup>2</sup> In short, the words “conical” and “conically” are modifiers and, in substance, mean the same thing, the only difference being a grammatical one.

Furthermore, we disagree with appellant’s contention on page 2 of the request for rehearing that the dictionary definition for the word “conical” is broad enough to encompass shapes other than conical shapes. According to its dictionary definition,<sup>3</sup> the word “conical” is defined as resembling or having the shape of cone (which comports with appellant’s proposed dictionary definition). By definition, therefore, “conical” excludes shapes (e.g., cylindrical shapes) other than shapes resembling a cone. In short, a

---

<sup>1</sup> Shaw, Errors in English, (2<sup>nd</sup> ed., New York, Barnes & Noble, 1970) p. 268. A copy of page 268 is appended to this decision on rehearing.

<sup>2</sup> Id.

<sup>3</sup> See Webster’s Third New International Dictionary (G. & C. Merriam Company, 1971).

cylindrical shape does not resemble a cone and thus may not be construed as having a conical shape.<sup>4</sup>

Furthermore, appellant has not introduced sufficient evidence to establish that the adjective “conical” or its adverbial counterpart “conically” has acquired a meaning in the catalytic converter art to include cylindrical shapes or other non- conical shapes. With regard to the cited Nara et al. Patent No. 4,279,864, the “[c]onverged ends 32a and 32b” (column 1, line 21) are shown to be separate from the conical pipes 3a and 3b. Figure 3 of this patent does not relate to the prior art converter of Figure 1. Instead, Figure 3 illustrates a sealing member for the Nara et al. invention. Even if the term “conical” was used in a misdescriptive sense in the Nara et al. patent to include “converged” (whatever that may mean) ends or “diverged” ends, such misuse in a single patent does not establish that “conical” is typically used in the catalytic converter art to include a cylindrical shape. The Nara et al. patent is equivocal at best.

We are not unmindful of appellant’s reliance on In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed Cir. 1997). However, this case supports our position, not appellant’s position.

In Morris, 127 F.3d at 1056, 44 USPQ2d at 1029 the court observed that, with regard to the claim language in issue, the appellant failed to make his intended meaning “explicitly clear” (emphasis added). The Morris court went on to hold that interpreting the claim language in light of the Morris patent specification was of no avail to the appellant because the specification failed to set forth the definition now sought by the

---

<sup>4</sup> In this context the word “shape” is used as a noun. It therefore is grammatically correct to use the modifier “conical.”

appellant. Id. The same is true in the case at bar. Appellant's specification does not make it clear that the expression "conical shaped wall" may include a cylindrical shape or other non-conical shapes.

Accordingly, the expression "conical shaped wall" must be given its ordinary and accustomed meaning. See Lantech, Inc. v. Keip Machine Company, 32 F. 3d 542, 547, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). See also Cortland Line Co. v. Orvis Co., 203 F.3d 1351, 1356, 53 USPQ2d 1734, 1737 (Fed. Cir. 2000) ("Claim terms receive their ordinary and customary meaning unless the patentee assigns a special meaning."). The ordinary and accustomed dictionary meaning of "conical" in the expression "conical shaped wall" excludes cylindrical and other non-conical shapes. Therefore, the original specification as filed lacks descriptive support for the claim limitations discussed in our § 112, first paragraph, rejection of the appealed claims as set forth in our decision dated January 31, 2001.

In light of the foregoing, appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

Appeal No. 1999-0681  
Application No. 08/697,478

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

|                                    |   |                 |
|------------------------------------|---|-----------------|
| HARRISON E. MCCANDLISH             | ) |                 |
| Senior Administrative Patent Judge | ) |                 |
|                                    | ) |                 |
|                                    | ) |                 |
|                                    | ) | BOARD OF PATENT |
| IRWIN CHARLES COHEN                | ) | APPEALS AND     |
| Administrative Patent Judge        | ) | INTERFERENCES   |
|                                    | ) |                 |
|                                    | ) |                 |
|                                    | ) |                 |
| LAWRENCE J. STAAB                  | ) |                 |
| Administrative Patent Judge        | ) |                 |

HEM/sld

Appeal No. 1999-0681  
Application No. 08/697,478

CARY W. BROOKS  
GENERAL MOTORS CORPORATION  
P. O. BOX 33114  
DETROIT, MI 48232